32.   The program storage device as in Claim 21, where in the step of transferring messages between the second protocol layer and the protocol service provider further includes the step of providing recovery information to the communication subsystem controller during the transfer of messages from one of the second protocol layer and the protocol service provider to the communication subsystem controller.

33.   The program storage device as in Claim 32, wherein the step of transferring messages between the application program and the application service provider further includes the step of providing recovery information to the communication subsystem controller during the transfer of messages from the application service provider to the communication subsystem controller.

34.   The program storage devices as in Claim 33, the method steps further comprising the step of storing the recovery information in the persistent storage for resuming the transfer of messages during recovery activities.

REMARKS

The issues outstanding in the instant application are as follows:

—   Claims 1-34 are rejected under 35 U.S.C. § 103(a).

Applicant hereby traverses the outstanding rejection, and requests reconsideration and withdrawal in light of the remarks contained herein. Claims 1-34 are pending in this application.

Rejection under 35 U.S.C. § 103(a)

Claims 1-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Choquier et al. ('668, hereinafter Choquier) in view of Pearson ('754).

A Prima Facie case of obviousness has not been established.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. §

2143. Without conceding the second criteria, Applicant asserts that the rejection does not satisfy the first and third criteria.

The Office Action does not provide the requisite motivation.

The Office Action admits that Choquier does not teach building the protocol stack in such detail as using the plurality of protocol layers and the communication subsystem controller, wherein the communication subsystem controller forms interfaces between the application program and its adjacent protocol layer in the protocol stack and at least between a pair of adjacent protocol layers in the protocol stack for transferring messages. The Office Action attempts to cure this deficiency by introducing Pearson, which the Office Action alleges to teach having such elements. The motivation for making the combination was presented as follows:

> "It would have obvious ... to incorporate the detailed protocol stack, shown by Pearson, in to the gateway system, taught by Choquier in order to easily disclosed the relationship of the layers. One of ordinary skill in the art would have been motivated to modify Choquier to include the detailed protocol stack in view of Pearson, so that a user could replicate the stack easily."

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. The layers of Choquier, and their relationships, are already disclosed, see FIGURE 5A of Choquier. Thus, the teaching of Pearson is not needed for such disclosure. Furthermore, there is no need for the stack of Choquier to be replicated. Choquier does not describe any operations where replicating stacks is necessary. Thus, the teaching of Pearson is not needed for such replication. Moreover, Pearson does not describe how its protocol stack would allow for such replication. Thus, there is no teaching that Pearson would more easily allow replication. Therefore, the motivational language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

No valid suggestion has been made as to why a combination of and common knowledge is desirable. Therefore, the rejection of claims 1-34 should be withdrawn.

The recited combination does not teach or suggest all claimed limitations.

The Office Action admits that Choquier does not teach building the protocol stack in such detail as using the plurality of protocol layers and the communication subsystem controller, wherein the communication subsystem controller forms interfaces between the application program and its adjacent protocol layer in the protocol stack and at least between a pair of adjacent protocol layers in the protocol stack for transferring messages. The Office Action attempts to cure this deficiency by introducing Pearson, which the Office Action alleges to teach having such elements. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claim 1 defines a method for transferring messages among an application program and a plurality of protocol layers in a communication subsystem of a computer using a communication subsystem controller, the computer being connected to a communication network and having a memory and at least one processor. The method comprising the steps of building a protocol stack using the plurality of protocol layers and the communication subsystem controller, wherein the communication subsystem controller forms interfaces between the application program and its adjacent protocol layer in the protocol stack and at least between a pair of adjacent protocol layers in the protocol stack for transferring messages; enabling the adjacent protocol layer to the application program to be an application service provider in response to the application program; enabling a first protocol layer in the pair of adjacent protocol layers in the protocol stack to be a protocol service provider in response to a second protocol layer in the pair of adjacent protocol layers in the protocol stack...

Claim 15 defines a communication subsystem of a computer form providing connectivity to a communication network, the computer having an application program, a memory and at least one processor, wherein messages are transferred among the application program and a plurality of protocol layers in the communication subsystem using a communication subsystem controller, the communication subsystem using a communication subsystem controller. The communication subsystem comprising a protocol stack having the plurality of protocol layers, and the communication subsystem controller, wherein the communication subsystem controller forms interfaces between the application program and

its adjacent protocol layer in the protocol stack and at least between a pair of adjacent protocol layers of the protocol stack and between for transferring messages. The communication subsystem also comprising the adjacent protocol layer to the application program being enabled an application service provider in response to the application program; and a first protocol layer in the pair of adjacent protocol layers in the protocol stack being enabled as a protocol service provider in response to a second protocol layer in the pair of adjacent protocol layers in the protocol stack.

Contrary to the Office Action, Choquier does not disclose these limitations. The protocol stack of claims 1 and 15 comprises the plurality of protocol layers and the interfaces of the communication subsystem controller. The sections of Choquier being relied upon in the Office Action as teaching these elements are not in the same stack. For example, in rejecting the step of enabling the adjacent protocol layer ... of claim 1, the Office Action cites the text of Choquier at column 12, line 6 to column 13, line 38. This section of Choquier discusses the MPC layer 502a, 502b of FIGURE 5A. In rejecting the step of enabling a first protocol layer in the pair of adjacent protocol layers ... of claim 1, the Office Action cites the text of Choquier at column 13, lines 4-34 and column 18, lines 10-54. These sections of Choquier discuss layer 519 and program 520 of FIGURE 5A, and MCP layer 208a, and 208b of FIGURE 5A, respectively. As is apparent from the FIGURE, all of the recited layers are not in the same stack as required by claims 1 and 15. For example, layer 502a and layer 208a are located in the client 102, while layer 519 and layer 208b are located in the gateway 126. Thus, Choquier does not teach these claimed limitations and Pearson is not relied upon as teaching these claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claims 1 and 15 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 2-14 and 16-34 depend directly from base claims 1 and 15, respectively, and thus inherit all limitations of their respective base claims. Each of claims 2-14 and 16-34 set forth features and limitations not recited by the combination of Choquier and Pearson. Thus, Applicant respectfully asserts that for the above reasons claims 2-14 and 16-34 are patentable over the 35 U.S.C. § 103(a) rejection of record.

CONCLUSION

For all the reasons given above, Applicant submits that the pending claims distinguish over the prior art of record under 35 U.S.C. § 103. Accordingly, Applicant submits that this application is in full condition for allowance.

Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.
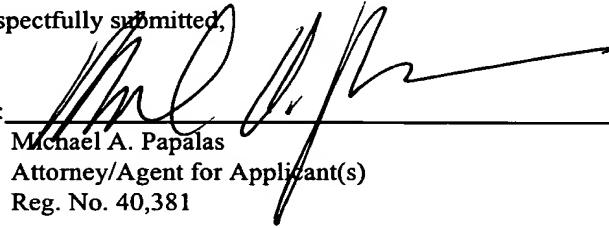
Date of Deposit: November 17, 2000

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